

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

First Named Inventor: Alan Wightman

Application No.: 09/869,745

Examiner: PIZIALI, Andrew T.

Filing Date: 9/28/2001

TC/A.U.: 1771

Title: Paper and Related Products of Improved Wet Expansion Profile

Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Sir,

**RESPONSE TO RESTRICTION OR ELECTION REQUIREMENT**

The Office Communication dated 3/1/2007 for the above application imposed a two way restriction requirement between the asserted inventions of Groups:

- I. claims 34-35 and 37-41, drawn to bonded casing paper
- II. claims 45-53, drawn to a method of preparing a casing paper

In order to strictly comply with the Examiner's requirement in the above restriction requirement, and without agreeing to the propriety of the restriction requirement, Applicant elects, with traverse, the invention of Group I, including claims 34-35 and 37-41 drawn to bonded casing paper. This requirement is traversed for at least the following reasons.

**The pending claims have unity of invention and the Restriction should be withdrawn**

- **Requirements for a proper restriction for lack of unity of invention.**

- PCT RULE 13.1.

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").

- PCT RULE 13.2.

Circumstances in Which the Requirement of Unity of Invention Is To Be

Considered Fulfilled

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

- 37 CFR 1.475 *Unity of invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage.*

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1) A product and a process specially adapted for the manufacture of said product; or . . .

- MPEP §1850(I), Rev. 5, Aug. 2006, page 1800-94

. . . when the Office considers international applications as an International Searching Authority, as an International Preliminary Examining Authority, and during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111.

- MPEP §1850(II), Rev. 5, Aug. 2006, page 1800-94 to 1800-95

An international application should relate to only one invention or, if there is more than one invention, the inclusion of those inventions in one international

application is only permitted if all inventions are so linked as to form a single general inventive concept (PCT Rule 13.1). With respect to a group of inventions claimed in an international application, unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" is defined in PCT Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).

Whether or not any particular technical feature makes a "contribution" over the prior art, and therefore constitutes a "special technical feature," should be considered with respect to novelty and inventive step.

...  
Although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor maintained on the basis of a narrow, literal or academic approach.

- MPEP §1850(III), Rev. 5, Aug. 2006, page 1800-96, with bolding added.

### III. < ILLUSTRATIONS OF PARTICULAR SITUATIONS

There are three particular situations for which the method for determining unity of invention contained in PCT Rule 13.2 is explained in greater detail:

#### (A) Combinations of different categories of claims;

...  
Principles for the interpretation of the method contained in PCT Rule 13.2, in the context of each of those situations are set out below. It is understood that the principles set out below are, in all instances, interpretations of and not exceptions to the requirements of PCT Rule 13.2.

#### A. Combinations of Different Categories of Claims

The method for determining unity of invention under PCT Rule 13 shall be construed as **permitting**, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

(A) In addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product; or

...

A process is specially adapted for the manufacture of a product if it inherently results in the product . . .

Thus, a process shall be considered to be specially adapted for the manufacture of a product if the claimed process inherently results in the claimed product with the technical relationship being present between the claimed product and claimed process. The words "specially adapted" are not intended to imply that the product could not also be manufactured by a different process.

- MPEP § 1893.03(d); Rev. 5, Aug 2006, page 1800-199 to 1800-200.

37 CFR 1.499 *Unity of invention during the national stage*

Examiners are reminded that unity of invention (not restriction) practice is applicable in international applications (both Chapter I and II) and in national stage applications submitted under 35 U.S.C. 371. Restriction practice continues to apply to U.S. national applications filed under 35 U.S.C. 111(a), even if the application filed under 35 U.S.C. 111(a) claims benefit under 35 U.S.C. 120 and 365(c) to an earlier international application designating the United States or to an earlier U.S. national stage application submitted under 35 U.S.C. 371.

When making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.

The principles of unity of invention are used to determine the types of claimed subject matter and the combinations of claims to different categories of invention that are permitted to be included in a single international or national stage patent application. See MPEP § 1850 for a detailed discussion of Unity of Invention. The basic principle is that an application should relate to only one invention or, if there is more than one invention, that applicant would have a right to include in a single application only those inventions which are so linked as to form a single general inventive concept.

A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. For example, a corresponding technical feature is exemplified by a key defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with

the claimed key.

...

A process is "specially adapted" for the manufacture of a product if the claimed process inherently produces the claimed product with the technical relationship being present between the claimed process and the claimed product. The expression "specially adapted" does not imply that the product could not also be manufactured by a different process.

...

- MPEP §803, Rev. 5, Aug. 2006, page 800-4 with underlining added.

"If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

- **The Office communication restriction.**

The Office communication asserts:

The inventions listed in Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under Rule 13.2, they lack the same corresponding special technical features for the following reason: Any international application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (see MPEP 1850). As demonstrated by the art cited in the previous rejection, in particular, as demonstrated by USPN 6,395,356 to Wielockx and/or USPN 3,822,182 to Heyse, the special technical feature of the application is obvious in view of the prior art. Consequently, the inventions listed as Groups I and II do not relate to a single inventive concept under PCT Rule 13.1.

The Office communication does not explicitly state that the restriction is made on the basis that the pending claims lack unity of invention. However, the language used and reference to the PCT Rules leads Applicant to believe that an asserted lack of unity of invention is the basis of this restriction.

- **Applicant's independent claims.**

Pending independent claims 34 and 45 are reproduced below.

34. A bonded casing paper comprising a nonwoven web material comprising cellulosic and synthetic fibres selected from at least one of polyamide fibres, polyamide copolymer fibres, polyester fibres, polyester copolymer fibres, polyolefin fibres and polyolefin copolymer fibres, bonded with regenerated cellulose or an epichlorohydrin containing resin and dried using a plurality of heated cylinders, wherein the web material has a lower cross direction wet expansion profile than a similar web material comprising only the same cellulosic fibres.

45. A method of preparing a casing paper having a lowered variation in cross direction wet expansion, comprising:

preparing a liquid dispersion of cellulosic fibers and synthetic fibers selected from at least one of polyamide fibers, polyamide copolymer fibers, polyester fibers, polyester copolymer fibers, polyolefin fibers and polyolefin copolymer fibers;

forming a base web of cellulosic and synthetic fibers from the dispersion; bonding the fibers of the base web with regenerated cellulose or an epichlorohydrin containing resin; and

at least partially drying the base web using a plurality of heated cylinders, wherein the bonded base web exhibits a lower cross direction wet expansion profile than a similar web material comprising only the same cellulosic fibres.

- Applicant's independent claims are permitted under the PCT Rules and the MPEP.

Applicant's pending claim 34 is a bonded casing paper. Applicant's pending claim 45 is a process for making the bonded casing paper of claim 34. The process of claim 45 would inherently produce the bonded casing paper of claim 34. Thus, Applicant's process of claim 45 is specially adapted to produce the bonded casing paper of claim 34.

As stated in MPEP §1850(III), "The method for determining unity of invention under PCT Rule 13 shall be construed as **permitting**, in particular, the inclusion of . . . an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product; . . ."

The MPEP explicitly permits Applicant's application to maintain unity of invention while including claim 34 (directed to a product) and claim 45 (directed to a process

specially adapted to produce the product).

- Applicant's independent claims each include the same "special technical features".

- Applicant's claims 34 and 45 are each directed to casing paper.
- Applicant's claims 34 and 45 each include substantially similar fiber combinations.
- Applicant's claims 34 and 45 each include regenerated cellulose or an epichlorohydrin containing resin as a bonding agent.
- Applicant's claims 34 and 45 each recite that the web is dried on heated cylinders.
- Applicant's claims 34 and 45 each recite that the web material has a lower cross direction wet expansion profile than a similar web material comprising only the same cellulosic fibres.

- Applicant's "special technical features" are not present in the cited references.

The present Office communication asserts: "As demonstrated by the art cited in the previous rejection, in particular, as demonstrated by USPN 6,395,356 to Wielockx and/or USPN 3,822,182 to Heyse, the special technical feature of the application is obvious in view of the prior art."

On November 30, 2006 Applicant filed a Response to the then pending claim rejections. In that Response Applicant made, *inter alia*, the following points.

- None of the cited references teaches or suggests a bonded casing paper wherein the bonded base web exhibits a lower cross direction wet expansion profile than a similar web material comprising only the same cellulosic fibres or a method of making such a bonded casing paper.
- The previous Office communication admitted that: "Wielockx . . . fails to disclose the use of the combination of both cellulosic and synthetic fibers.
- The previous Office communication admitted that: ". . . Wielockx does not

specifically teach drying by means of a plurality of heated cylinders . . .”

- The Heyse reference is directed to a drying process NOT using heated cans or drums, e.g. heated cylinders, that restrains the wet web while passing hot air through the restrained web. See column 4, line 69 to column 5, line 3. It is an object of the Heyse invention to provide “a method of drying porous tissue web material . . . by means of a single through drying unit capable of restrainably holding the web material during its entire drying cycle. See column 2, lines 52-56. The Heyse reference teaches, with bolding added, that it is “**essential** in accordance with the present invention that the restrained conditions be maintained in a continuous and uninterrupted manner as the web is dried . . .” See column 5, lines 35-37. The Heyse Examples 1-3 distinguish the inventive material (samples 1-3) dried by restrained air percolation as being superior to material dried on conventional can dryers (sample A). In sum, the object of the Heyse reference, and an essential part of the Heyse invention, is to NOT use heated cylinders to dry a web.

In sum, none of the cited references, including US 6,395,356 to Wielockx and US 3,822,182 to Heyse, singly or in combination, teaches or suggests all of the features recited in Applicants pending claims 34 or 45. Further, this restriction is being imposed under the premise that the cited references DO suggest Applicant’s claimed features, although the Office has not responded to Applicant’s previous contentions of record that such is not the case.

Since the features recited in Applicant’s pending claims 34 and 45 are not taught or suggested by the cited references and since claims to a product and a method of inherently making that product are allowed under the PCT Rules, Applicant’s pending claims 34 and 45 DO have unity of invention. This restriction is respectfully traversed for at least this reason.

Further, the restriction requirement respectfully appears too restrictive. The Examiner has not shown it would be a “serious burden” to perform a complete search and examination on all of the claims as originally filed. This is especially true when the



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two independent claims are related. This restriction is respectfully traversed for at least this reason.

Respectfully submitted,

Alan Wightman et al

Date: April 2, 2007  
750 Main Street- Suite 1400  
Hartford, CT 06103-2721  
(860) 527-9211

By: /s/ James E. Piotrowski  
James E. Piotrowski  
Registration No. 43,860  
Alix, Yale & Ristas, LLP  
Attorney for Applicants

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